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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Jones et al.

Serial No.: 10/644,256

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Examiner: M. Joike

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**RENEWED PETITION UNDER 37 C.F.R. §§ 1.78(a)(3), 1.78(a)(6), AND 1.55(c) FOR
ACCEPTANCE OF UNINTENTIONALLY DELAYED PRIORITY CLAIMS**

Mail Stop Legal PCT
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P.O. Box 1450
Alexandria, Virginia 22313-1450

Sir:

In response to the Decision on Second Renewed Petition, received on August 23, 2010, the applicants respectfully renew their petition under 37 C.F.R. § 1.78(a)(3); 37 C.F.R. § 1.78(a)(6); and 37 C.F.R. § 1.55(c) for the acceptance of their unintentionally delayed priority claims.

Factual Background:

On November 16, 2006, the applicants submitted an initial request for the acceptance of an unintentionally delayed priority claim in the context of a response to an Office Action dated

August 23, 2006. The request was accompanied by the requisite fee under 37 C.F.R. § 1.17(t). The request was subsequently denied in an Office Action dated February 28, 2007. Thereafter, the applicants submitted a formal Petition for Acceptance of an Unintentionally Delayed Priority Claim on June 14, 2007. This Petition was dismissed in a Decision dated September 30, 2008. Subsequently, the applicants filed a Renewed Petition on November 24, 2008. This Renewed Petition was dismissed on July 7, 2009.

On August 21, 2009, the applicants filed a further renewed Petition under 37 C.F.R. § 1.78(a)(6) for Acceptance of Unintentionally Delayed Priority Claims. The renewed Petition was directed to the addition of two sets of priority claims. The first set of priority claims concerned domestic priority claims under 35 U.S.C. §§ 120 and 365(c), directed to two international applications, together with associated priority claims to a US provisional application under 35 U.S.C. § 119(e). The second set of priority claims were directed to a domestic priority claim to an international application under 35 U.S.C. §§ 120 and 365(c), together with an associated priority claim to a foreign application under 35 U.S.C. § 119(a)-(d).

Applicants' Petition was dismissed in a Decision dated March 9, 2010. In his Decision, the Legal Examiner determined, pursuant to 37 C.F.R. §§ 1.178(a)(3) and 1.78(a)(6), the following with respect to the first set of priority claims, namely:

1. The Petition was filed after November 29, 2000, and therefore the Petition was properly submitted after the time periods specified in 37 C.F.R. §§ 1.78(a)(2)(ii) and 1.78(a)(2)(i), and therefore the Petition was a proper petition under 37 C.F.R. §§ 1.78(a)(3) and 1.78(a)(6).
2. The surcharge required by 37 C.F.R. § 1.17(t) was timely submitted;
3. The Statement that the entire delay between the date the claim was due under 37 C.F.R. §§ 1.78(a)(2)(ii) and 1.78(a)(5)(ii) and the date the claim was filed was unintentional was properly submitted.

With respect to the final requirement under 37 C.F.R. 1.78, namely that the applicants provide the reference required by 35 U.S.C. §§ 120 and 119(e), and 37 C.F.R. §§ 1.78(a)(2)(i)

and 1.78(a)(5)(i), to the prior filed application, the Legal Examiner determined that the applicants had submitted an acceptable reference with respect to the claim of priority under 35 U.S.C. §§ 120 and 365(c) to international application PCT/EP2003/007690, and through that international application under 35 U.S.C. § 119(e) to U.S. provisional application 60/397,066. It follows that with respect to the priority claim directed to PCT/EP2003/007690 and U.S. provisional application 60/397,066., the Legal Examiner determined that the Petition had met all of the statutory requirements for an acceptance of the priority claim.

With respect to the final requirement of providing the reference to the domestic priority claim under 35 U.S.C. §§ 120 and 365(c) with respect to international application PCT/EP03/50201, and through that international application under 35 U.S.C. § 119(e) to U.S. provisional application 60/397,066, the Legal Examiner determined that the applicants had failed to submit a proper reference. Specifically, the Legal Examiner noted that international application PCT/EP03/50201 was not published by the International Bureau (IB), and therefore it was not possible, given the present record, to ascertain whether the instant application was filed during the pendency of international application PCT/EP03/50201. In reaching his decision, the Legal Examiner cited MPEP § 1895.01 and its requirement that the applicants certify that the international application was not withdrawn or considered withdrawn prior to the filing date of the national application which claimed the benefit under 35 U.S.C. §§ 120 and 365(c).

In his Decision, the Legal Examiner indicated that should the applicants wish to renew their petition, the applicants would be required to provide a copy of PCT/EP03/50201 together with a certification and documentary support confirming that international application PCT/EP03/50201 was not withdrawn prior to the filing date of the instant application. Furthermore, the Legal Examiner indicated that the applicants would also need to establish that PCT/EP03/50201 named at least one inventor in common with the instant application. As a final requirement, the Legal Examiner further required that the applicants provide a substitute amendment containing a proper reference to the prior-filed international applications and the provisional application.

Regarding the second set of priority claims, *i.e.* the priority claim directed to PCT/EP03/50201 and its associated claim to foreign priority claim under 35 U.S.C. § 119(a)-(d) to EP application 02077953.4, the Legal Examiner first determined that the proper basis of

applicants' petition was 35 U.S.C. § 365(b) instead of 35 U.S.C. § 365(c). The Legal Examiner further concluded that such a petition, in order to be granted, must meet the provisions of 37 C.F.R. § 1.55(c). In analyzing the second set of priority claims under 37 C.F.R. § 1.55(c), the Legal Examiner determined as follows:

1. The instant application was filed after November 29, 2000, and therefore the Petition was properly submitted after the time periods specified in 37 C.F.R. § 1.55(c) and therefore the Petition was a proper petition under 37 C.F.R. § 1.55(c).
2. Applicants' priority claim, as identified in the Declaration filed on November 20, 2006, in the instant application, had properly identified the prior foreign application for which priority was claimed by application number, country and filing date.
3. The surcharge required by 37 C.F.R. § 1.17(t) was timely paid.
4. The Statement that the entire delay, between the date the claim was due under 37 C.F.R. § 1.55(a)(1) and the date the claim was filed, was unintentional was properly submitted.

With respect to the final requirement, namely that the nonprovisional application must be filed within 12 months of the filing date of the referenced foreign application, *i.e.* the filing date of EP application 02077953.4, the Legal Examiner determined that the applicants had failed to meet their obligation. Specifically, the Legal Examiner determined that the filing date of the instant application, namely August 20, 2003, was not within 12 months of the July 18, 2002, filing date of EP application 02077953.4. In reaching his decision, the Legal Examiner noted that notwithstanding his determination, this final requirement would be satisfied in a renewed petition if applicants could successfully add a claim of domestic priority to prior filed international application PCT/EP2003/007690 or international application PCT/EP03/50201, since the filing date of the EP application 02077953.4 would then be within 12 months of the filing date of either of these two international applications.

On May 17, 2010, the applicants filed yet a further renewed Petition under 37 C.F.R. §§ 1.78(a)(3), 1.78(a)(6), and 1.55(c) for Acceptance of Unintentionally Delayed Priority Claims together with an Amendment under 37 C.F.R. § 1.116 requesting, *inter alia*, that the Office amend the Specification to incorporate references to priority documents. This renewed Petition was dismissed in a Decision on Second Renewed Petition, mailed August 23, 2010. As stated in this Decision, the Legal Examiner determined that the Petition could not be granted until appropriate references to the priority documents were introduced into the application. Therefore, since the Examiner indicated that she would not enter the Amendment under 37 C.F.R. § 1.116 that had been submitted with the Petition, and the case had been finally rejected, the Office determined that the Petition could not be granted.

On August 31, 2010, the applicants' attorney, Alexander Stein, participated in a telephone conference with Richard M. Ross of the Office of PCT Legal Administration. The applicants are extremely grateful for the courtesy shown by the Office in conducting this interview. During the interview, Mr. Ross indicated that the Office could not procedurally grant the Petition until prosecution had been reopened by the filing of a Request for Continued Examination, and an Amendment incorporating appropriate references to the priority documents into the application was also submitted. It is the applicants' understanding from the interview that additional copies of the materials submitted with the last renewed petition (*i.e.*, a certified copy of PCT International Patent Application No. PCT/EP03/50201; a copy of the Receipt of Electronic Submission for PCT/EP03/50201; a copy of the Invitation to Pay Prescribed Fees for PCT/EP03/50201; and a copy of the Notification that International Application Considered to be Withdrawn for PCT/EP03/50201) do not need to be re-submitted with the present Petition. If this understanding is incorrect, the Office is respectfully requested to contact the applicants' attorney at the phone number provided herein. The applicants believe that the foregoing adequately describes the interview. If, however, the Office believes more detail to be desirable, the Office is kindly requested to contact the applicants' attorney, and more detail will be provided to the extent available.

Applicants' Renewed Petition Regarding the Priority Claim to PCT/EP2003/007690 and the Accompanying Priority Claim to U.S. Provisional 60/397,066:

Pursuant to 37 C.F.R. § 1.78(a)(3) and 37 C.F.R. § 1.78(a)(6), applicants hereby renew their petition to be afforded, under 35 U.S.C. § 120, a claim of domestic priority to PCT International Patent Application No. PCT/EP2003/007690, and through this international application a claim of domestic priority under 35 U.S.C. §§ 119(e) and 365(c) to U.S. Provisional application 60/397,066. In support of this petition applicants submit as follows:

1. Applicants' application was filed on August 20, 2003, and was therefore filed after November 29, 2000. Accordingly, the applicants' claims are submitted after the expiration of the periods specified in 37 C.F.R. §§ 1.78(a)(2)(ii) and 1.78(a)(5)(ii). It follows there from that the instant petition is proper under 37 C.F.R. §§ 1.78(a)(3) and 1.78(a)(6).
2. The references to the prior filed applications, required by 35 U.S.C. §§ 120 and 119(e) and 37 C.F.R. §§ 1.78(a)(2)(i) and 1.78(a)(5)(i), are properly set forth in the Amendment to the specification of the application which is being filed simultaneously herewith. A copy of the Amendment is attached hereto as Exhibit A. The applicants respectfully submit that the Amendment properly identifies International Patent Application No. PCT/EP2003/007690 and its continuation-in-part relationship to the instant application. Furthermore, the Amendment also properly identifies U.S. Provisional application 60/397,066 and the 35 U.S.C. § 119(e) claim of priority to that provisional application through International Patent Application No. PCT/EP2003/007690. In view of the submission of this Amendment, the applicants submit that the reference requirements under 35 U.S.C. §§ 119(e), 120, and 365(c) and 37 C.F.R. §§ 1.78(a)(3) and 1.78(a)(6) have been satisfied.
3. The surcharge required under 37 C.F.R. § 1.17(t) was previously submitted in

conjunction with applicants' prior request dated November 16, 2006.

4. Applicants hereby state that the entire delay between the date the claim was due under 37 C.F.R. §§ 1.78(a)(2)(ii) and 1.78(a)(5)(ii) and the date that the claim was filed was unintentional.

In view of the prior indications of the Legal Examiner, the applicants respectfully submit that the above petition for the acceptance of a priority claim to International Patent Application No. PCT/EP2003/007690, and through this international application, the priority claim to U.S. Provisional application 60/397,066, should now be in acceptable form. Reconsideration of the petition with respect to these priority claims is therefore requested.

Applicants' Renewed Petition Regarding the Priority Claim to PCT/EP2003/50201 and the Accompanying Priority Claim to U.S. Provisional 60/397,066:

Pursuant to 37 C.F.R. § 1.78(a)(3) and 37 C.F.R. § 1.78(a)(6), the applicants hereby renew their petition to be afforded, under 35 U.S.C. § 120, a claim of domestic priority to PCT International Patent Application No. PCT/EP2003/50201, and through this international application, a claim of domestic priority under 35 U.S.C. §§ 119(e) and 365(c) to U.S. Provisional application 60/397,066. In support of this petition, the applicants submit as follows:

1. Applicants' application was filed on August 20, 2003, and was accordingly filed after November 29, 2000. Therefore, the applicants' claims are submitted after the expiration of the periods specified in 37 C.F.R. §§ 1.78(a)(2)(ii) and 1.78(a)(5)(ii). It follows that the instant petition is proper under 37 C.F.R. §§ 1.78(a)(3) and 1.78(a)(6).
2. The references to the prior filed applications, required by 35 U.S.C. §§ 120 and 119(e) and 37 C.F.R. §§ 1.78(a)(2)(i) and 1.78(a)(5)(i), are properly set forth in the Amendment to the specification of the application which is being filed simultaneously

herewith. As noted previously, a copy of the Amendment is attached hereto as Exhibit A. The applicants respectfully submit that the Amendment properly identifies International Patent Application No. PCT/EP2003/50201 and its continuation-in-part relationship to the instant application. Furthermore, the Amendment also properly identifies U.S. Provisional application 60/397,066 and the claim of priority to that provisional application under 35 U.S.C. §§ 119(e) and 365(c) through International Patent Application No. PCT/EP2003/50201.

In his prior decision, the Legal Examiner had indicated that a proper reference to International Patent Application No. PCT/EP2003/50201 and U.S. Provisional application 60/397,066 would require the applicants, under the provisions of MPEP § 1895.01, to certify that International Patent Application No. PCT/EP2003/50201 was pending as of the filing date of the instant application; *i.e.* that the international application was pending on August 20, 2003. Responsive to the Legal Examiner's request, the applicants hereby affirmatively certify that International Patent Application No. PCT/EP2003/50201 was a validly pending application on August 20, 2003. In support of their certification, the applicants reference the as-filed copy of International Patent Application No. PCT/EP2003/50201, certified by the European Patent Office (EPO) and submitted as Exhibit B with the Petition filed on May 17, 2010. The EPO was the International Receiving Office for International Patent Application No. PCT/EP2003/50201. A review of the certified copy will verify that the application was filed on May 27, 2003, with the EPO. Further confirmation of this filing was submitted with the Petition filed on May 17, 2010, in the form of a Receipt of Electronic Submission, attached thereto as Exhibit C.

With regard to the pendency of International Patent Application No. PCT/EP2003/50201, as noted on the Receipt of Electronic Submission, this application was initially filed without the payment of a filing fee. On August 4, 2003, the EPO issued an Invitation to Pay Prescribed Fees Together with a Late Payment Fee under the provisions of PCT Rule 16bis. A copy of this Invitation was submitted with the Petition filed on May 17, 2010, as Exhibit D. This Invitation provided a one month period, *i.e.*

until September 4, 2003, for the applicants to pay the requested filing fees. Applicants did not submit the requested filing fees prior to the deadline. On September 23, 2003, the EPO formally issued a Notification That International Application Considered To Be Withdrawn pursuant to PCT Article 14(1) or (3) and Rule 29.1 or 92.4(g)(i). A copy of this Notification was submitted with the Petition filed on May 17, 2010, as Exhibit E. The issuance of this Notification acknowledged the withdrawal of this application effective September 23, 2010.

As documented by the Exhibits B-D, submitted with the Petition filed on May 17, 2010, International Patent Application No. PCT/EP2003/50201 was validly filed on May 27, 2003 and after review by the EPO PCT Receiving Office was accorded an international filing date. Moreover, International Patent Application No. PCT/EP2003/50201 was pending from its date of filing until September 23, 2003, when it was formally withdrawn by the European Patent Office. The instant application was filed during the one month period provided to the applicants under PCT Rule 16bis to pay the filing fee in International Patent Application No. PCT/EP2003/50201. It follows that International Patent Application No. PCT/EP2003/50201 was validly pending on August 20, 2003, when the instant application was filed. In this regard, the applicants respectfully direct the Legal Examiner's attention to paragraph 6.009 of the PCT User's Guide.

With regard to the Legal Examiner's requirement that applicants confirm that at least one inventor is commonly named on both the instant application and International Application No. PCT/EP03/50201, the Legal Examiner may note from the frontpiece of the certified copy of the as filed application that at least one inventor, namely Abraham Bout, is named in both International Patent Application No. PCT/EP2003/50201 and the instant application.

In view of the showing that International Patent Application No. PCT/EP2003/50201 was pending on the filing date of the instant application, and further given the identification of a common inventor on both international application no. PCT/EP03/50201 and the instant application, the applicants respectfully submit that the requirement of a reference to the prior filed applications as required by 35 U.S.C. §§ 120

and 119(e) and 37 C.F.R. §§ 1.78(a)(2)(i) and 1.78(a)(5)(i) has now been satisfied for purposes of the present petition.

3. The surcharge required under 37 C.F.R. § 1.17(t) was previously submitted in conjunction with applicants' prior Petition dated November 16, 2006.
4. Applicants hereby state that the entire delay between the date the claim was due under 37 C.F.R. §§ 1.78(a)(2)(ii) and 1.78(a)(5)(ii) and the date that the claim was filed was unintentional.

In view of the prior indications of the Legal Examiner, together with the facts set forth above, the applicants respectfully submit that the petition for the acceptance of a priority claim under 35 U.S.C. §§ 120 and 365(c) to International Patent Application No. PCT/EP2003/50201, and through this international application under 35 U.S.C. § 119(e) to U.S. Provisional application 60/397,066, should now be in acceptable form. Reconsideration of the petition with respect to these priority claims is therefore requested.

Applicants' Petition Regarding the Priority Claim to PCT/EP2003/50201 and the Accompanying Priority Claim to EP02077953.4:

Pursuant to 37 C.F.R. § 1.78(a)(3) and 37 C.F.R. § 1.78(a)(6), the applicants hereby renew their petition to be afforded, under 35 U.S.C. §§ 120 and 365(a), a claim of domestic priority to PCT International Patent Application No. PCT/EP2003/50201, and through this international application, pursuant to 37 C.F.R. § 1.55(c) and under 35 U.S.C. §§ 119(a)-(d) and 365(b), a claim of foreign priority to EP02077953.4. Applicants respectfully submit that the showing above with regard to the claim for domestic priority of PCT/EP2003/50201 adequately establishes the basis of the applicants' claim to that domestic priority. With regard to applicants' petition under 37 C.F.R. § 1.55(c) for a foreign priority claim under 35 U.S.C. §§ 119(a)-(d) and 365(b) as to EP02077953.4, the applicants submit as follows:

1. Applicants' application was filed on August 20, 2003, and was accordingly filed after November 29, 2000. Therefore, the applicants' claims are submitted after the expiration of the periods specified in 37 C.F.R. § 1.55(c). It follows that the instant petition is proper under 37 C.F.R. § 1.55(c).
2. The reference to EP02077953.4, the prior filed foreign application for which priority is claimed, has been properly made by identifying the application number, country and filing date of that application in the Declaration filed on November 20, 2006, in the instant application.
3. The surcharge required under 37 C.F.R. § 1.17(t) was previously submitted in conjunction with applicants' prior Petition dated November 16, 2006.
4. Applicants hereby state that the entire delay between the date the claim was due under 37 C.F.R. §§ 1.78(a)(2)(ii) and 1.78(a)(5)(ii) and the date that the claim was filed was unintentional.
5. The application, through which the present foreign priority claim is made, namely International Patent Application No. PCT/EP2003/50201, was filed within 12 months of the filing date of EP02077953.4. International Patent Application No. PCT/EP2003/50201 was filed on May 27, 2003. EP 02077953.4 was filed less than eleven months earlier on July 18, 2002. It follows that International Patent Application No. PCT/EP2003/50201 was filed within 12 months of the filing date of EP02077953.4.

In view of the prior indications of the Legal Examiner that a valid foreign priority claim to EP02077953.4 would exist provided that a proper domestic priority claim was established for International Patent Application No. PCT/EP2003/50201, further given the applicants' showing that such a domestic priority claim is factually and legally supported, and finally given the showing above that the instant Petition satisfies the conditions of 37 C.F.R. § 1.55(c), the

applicants respectfully submit that the foreign priority claim under 35 U.S.C. §§ 119(a)-(d) and 365(b) to EP02077953.4 should now be in acceptable form. Reconsideration of the petition with respect to this priority claim is therefore requested.

Authorization to Charge Deposit Account

Applicants note that, pursuant to 37 C.F.R. § 1.78(a)(3), the required surcharge set forth in § 1.17(t) was submitted in conjunction with the communication filed November 16, 2006. However, any fee required but not submitted with this communication may be charged to deposit account no. 20-1469.

CONCLUSION

Acceptance of the applicants' claim of domestic priority under 35 U.S.C. §§ 120 and 365(c) to PCT International Patent Application No. PCT/EP2003/007690 and International Patent Application No. PCT/EP03/50201 is requested. Acceptance of the applicants' claim to domestic priority under 35 U.S.C. §§ 119(e) and 365(c) to United States Provisional Application Serial No. 60/397,066, and their claim of foreign priority under 35 U.S.C. § 119(a)-(d) to European Patent Application No. 02077953.4 are also respectfully requested. If questions remain after consideration of the foregoing, or if the Office should determine that there are additional issues which might be resolved by telephone conference, the Office is kindly requested to contact the applicants' attorney at the address or telephone number given herein.

Respectfully submitted,

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Enclosure: Amendment

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